

Office Action Summary

Application No.

10/551,343

Applicant(s)

DEFAYE ET AL.

Examiner

LAYLA BLAND

Art Unit

1623

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-60 is/are pending in the application.
- 4a) Of the above claim(s) 30-33, 36, 39-41 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34, 35, 37, 38, 42-44, 46-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date: 20090113
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is a response to Applicant's amendment submitted October 6, 2008, wherein claims 30-56 and 58-60 are amended. Claims 30-33, 36, 39-41, 45, 46, and 51 were previously withdrawn. The election of species requirement mailed March 19, 2008 is now withdrawn. Thus, claims 30-33, 36, 39-41, and 45 are now withdrawn from consideration and claims 34, 35, 37, 38, 42-44, 46-60 are examined on the merits herein. Applicant timely traversed the restriction requirement mailed November 28, 2007 in the reply filed on December 28, 2007.

In view of Applicant's arguments submitted October 6, 2008, the rejection of claims 34, 35, 37, 38, 42-44, 47-50, and 52-60 under 35 USC 103(a) is withdrawn. Applicant's arguments are persuasive.

The following rejection is maintained:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 34, 35, 37, 38, 42-44, 46-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 34 (and dependent claims) and 48 recite the limitation "visualization probe or fluorescent or radioactive detection probe." Neither the claims nor the

Art Unit: 1623

specification define which moieties fit this limitation. Note that exemplification is not definition. Thus, the skilled artisan would not be aware of the metes and bounds of the claims.

The following new rejection was necessitated by Applicant's amendment submitted October 6, 2008, wherein "comprising" was added to claim 47:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 47 recites the limitation "comprising tris(2-hydroxymethyl)methylamine." "Comprising" is open language, permitting the inclusion of other elements in addition to tris(2-hydroxymethyl)methylamine. The structure of the branching element is unclear and thus the skilled artisan would not be aware of the metes and bounds of the claims.

Conclusion

This application contains claims drawn to an invention nonelected with traverse in the reply filed on December 28, 2007. Specifically, Group IV, drawn to cyclodextrin derivatives containing a biorecognition element, was elected. Thus, cyclodextrin derivatives not containing a biorecognition element are nonelected with traverse. The

biorecognition element is defined as "R" in the instant claims and is only present when Z represents a thiourea group. Thus, all compounds (and methods of making the compounds, if Applicant requests rejoinder of those claims upon allowance of the compounds) wherein R is NHX or a $^+NX_3$ are nonelected with traverse. A complete reply to the final rejection must include removal of nonelected subject matter or other appropriate action (37 CFR 1.144) See MPEP § 821.01. In a telephone conversation with Mr. Goozner on December 22, 2008, the Examiner recommended removal of the nonelected subject matter in order to expedite prosecution, and requested a reply from Mr. Goozner by close of business on January 9, 2008. No reply was received.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAYLA BLAND whose telephone number is (571)272-9572. The examiner can normally be reached on Monday - Friday, 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anna Jiang can be reached on (571) 272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shaojia Anna Jiang/
Supervisory Patent Examiner, Art Unit 1623

/Layla Bland/
Examiner, Art Unit 1623